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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			ZHOU, TING	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,230

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on 22 April 2004 have been received and entered. Of the original claims 1-25, claims 23-25 have been cancelled by the Applicant and are therefore withdrawn from consideration. Claims 26-28 have been added. Claims 1-22 and 26-28 as amended are pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-8, 12-15, 18-19 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn et al. U.S. Patent 5,751,287.

Referring to claims 1, 12 and 26, Hahn et al. teach a method, system and information storage medium for displaying a document comprising a display device and controller (computer system including display screen and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that displays a thumbnail (display of thumbnail views of pages in a document) (column 11, lines 46-52 and Figure 16) having at least one first selectable element, the thumbnail as a whole being selectable and having an original document as a first associated destination (the thumbnail as a whole can be selected and a page of the document can be displayed by selecting the thumbnail for the page) (column 12, lines 8-12), and the at least one first selectable element having, as a second

second associated destination, one of a portion of the original document , smaller than the original document as a whole (selecting a portion of the thumbnail page to display the selected portion) (column 12, lines 26-30) and a document other than the original document (other pages of the document can be selected and displayed by the user) (column 12, lines 12-40), receiving a selection of one of the thumbnail as a whole and the at least one first selectable element and accessing one of the first associated destination and the second associated destination, based on the selection (receiving user input selecting the page or a portion of the page and displaying the corresponding information) (column 4, lines 1-11), wherein the thumbnail is a reduced-size representation of at least a part of the original document (thumbnail region 1710 in Figure 16 gives a “thumbnail” view of the pages in the original document; in addition, it is noted that the definition of a thumbnail according to <http://www.webopedia> is a “miniature display of a page to be printed”, which a reduced sized representation of the page) (column 11, lines 41-56).

Referring to claims 2 and 13, Hahn et al. teach the portion of the original document being a document portion not uniquely associated with any selectable element provided in the original document (the user can directly select any portion of a thumbnail page) (column 12, lines 24-30).

Referring to claims 3 and 14, teach the portion of the original document being an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document (any portion of any page of the document can be selected and displayed by the user) (column 12, lines 12-40).

Referring to claims 4, 15 and 27, Hahn et al. teach a method, system and information storage medium for displaying a document comprising a display device and controller (computer system including display screen and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that

displays a thumbnail associated with an original document (display of thumbnail views of pages in a document) (column 11, lines 46-52 and Figure 16) and having at least one first selectable element, each of at least one first selectable element having, as an associated destination, one of an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document (the thumbnail as a whole can be selected and a page of the document can be displayed by selecting the thumbnail for the page) (column 12, lines 26-30) and a document other than the original document (any other page of the document can be selected and displayed by the user) (column 12, lines 12-40); receiving a selection of one of the at least one first selectable element and directly accessing the associated destination based on the selection (receiving user input selecting the page or a portion of the page and displaying the corresponding information) (column 4, lines 1-11), wherein the thumbnail is a reduced-size representation of at least a part of the original document (thumbnail region 1710 in Figure 16 which gives a “thumbnail” view of the pages in the original document; in addition, it is noted that the definition of thumbnail according to <http://www.webopedia> is a “miniature display of a page to be printed”, which a reduced sized representation of the page) (column 11, lines 41-56).

Referring to claims 7 and 18, Hahn et al. teach the document other than the original document being accessible by selection of a third selectable element provided in the original document (any other page in the document can be selected by the user) (column 12, lines 12-40).

Referring to claims 8 and 19, Hahn et al. teach the at least one first selectable element being a visibly discrete element, as shown by the separately selectable thumbnails in display area 1170 in Figure 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-11, 20-22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. U.S. Patent 5,751,287 and Brown et al. U.S. Patent 6,405,192.

Referring to claims 9, 20 and 28, Hahn et al. teach a method, system and information storage medium for displaying a document comprising a display device and a controller (computer system including display screen and GUI) (Hahn et al.: column 4, lines 58-67 and column 5, lines 1-7) that displays a thumbnail associated with an original document (display of thumbnail views of pages in a document) (Hahn et al.: column 11, lines 46-52 and Figure 16) and having at least one first selectable element, each of the at least one first selectable element having, as an associated destination, a portion of the original document, smaller than the original document and not uniquely associated with any selectable element provided in the original document (the thumbnail as a whole can be selected and a page of the document can be displayed by selecting the thumbnail for the page) (Hahn et al.: column 12, lines 26-30); receiving a selection of one of the at least one first selectable element and directly accesses the associated destination based on the selection (receiving user input selecting the page or a portion of the page and displaying the corresponding information) (Hahn et al.: column 4, lines 1-11), wherein the thumbnail is a reduced-size representation of at least a part of the original document

(thumbnail region 1710 in Figure 16 which gives a “thumbnail” view of the pages in the original document; in addition, it is noted that the definition of thumbnail according to <http://www.webopedia> is a “miniature display of a page to be printed”, which a reduced sized representation of the page) (Hahn et al.: column 11, lines 41-56). However, Hahn et al. fail to explicitly teach the thumbnail being an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67 and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document (modifying the appearances of the thumbnails by placing a dark border around the thumbnails that contain matches to the user’s undesirable criteria, adding a “Do Not Enter” icon indicating to the user that the linked page contains undesirable features or displaying the thumbnail with different colors, etc.) (Brown et al.: column 10, lines 2-25 and further shown in Figures 9-11). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users’ interests.

Referring to claims 10 and 21, Hahn et al. teach all of the limitation as applied to claim 9 above. However, Hahn et al. fail to explicitly teach the element with the modified appearance is the first selectable element. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67 and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach the element with the modified appearance is the first selectable element (the thumbnail, with a modified appearance is a link to a page from the search results that the user can select from) (Brown et al.: column 9, lines 64-67 through column 10, lines 1-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users' interests.

Referring to claims 11 and 22, Hahn et al. teach at least one first selectable element is not a visibly discrete element (the user can directly select any portion of the thumbnail) (column 12, lines 26-30).

4. Claims 5-6 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. U.S. Patent 5,751,287, as applied to claims 4 and 15 above, and Brown et al. U.S. Patent 6,405,192.

Referring to claims 5 and 16, Hahn et al. teach all of the limitations as applied to claims 4 and 15 above. However, Hahn et al. fail to explicitly teach the thumbnail being an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67 and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach an enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document (modifying the appearances of the thumbnails by placing a dark border around the thumbnails that contain matches to the user's undesirable criteria, adding a "Do Not Enter" icon indicating to the user that the linked page contains undesirable features or displaying the thumbnail with different colors, etc.) (Brown et al.: column 10, lines 2-25 and further shown in Figures 9-11). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users' interests.

Referring to claims 6 and 17, Hahn et al. teach all of the limitations as applied to claims 4 and 15 above. However, Hahn et al. fail to explicitly teach the element with the modified appearance is the first selectable element. Brown et al. teach a method and system for displaying thumbnails as a reduced size representation of a document (Brown et al.: column 9, lines 64-67

and Figure 9) similar to that of Hahn et al. In addition, Brown et al. further teach the element with the modified appearance is the first selectable element (the thumbnail, with a modified appearance is a link to a page from the search results that the user can select from) (Brown et al.: column 9, lines 64-67 through column 10, lines 1-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Hahn et al. and Brown et al. before him at the time the invention was made, to modify the thumbnails of Hahn et al. to include the display of the enhanced thumbnails with the modified appearances, taught by Brown et al. One would have been motivated to make such a combination in order to provide users with a tool to enable them to make more informed decisions about which links or pages to view, preventing them from wasting time with pages that are irrelevant to the users' interests.

Response to Arguments

5. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicants particularly pointed that the Hahn et al. reference does not teach the thumbnail as a whole has the original document as the first associated destination. However, on column 11, lines 46-56, Hahn et al. teach that the user can directly select any of the thumbnails in the thumbnail region representing the pages of the document; for example, each individual, whole thumbnail, such as the pages represented by thumbnails 2000, 2010, 2020 and 2030 in Figure 19A can be selected by the user to display the corresponding page. Accordingly, Hahn et al. teach the ability to access the original document as a whole and the ability to access a portion of

the document by directly selecting a portion of the thumbnail page (column 12, lines 24-30).

Therefore, Hahn et al. teach that the user can select the thumbnail as a whole, which displays the original, or entire page of the document, or a part of the original page of the document; the document accessible by the selecting the whole thumbnail displays the entire page, and therefore, it contains the fraction of the document that can be accessed by selecting a portion of the thumbnail.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeza can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15 June 2004

BA HUYNH
PRIMARY EXAMINER